

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 97-022-F3)

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|--|---|--------------------------------|
| In application of |) | |
| |) | |
| Dunlay, <i>et al.</i> |) | Examiner: Carolyn Smith |
| |) | |
| Serial No. 09/718,770 |) | |
| |) | Group Art Unit: 1631 |
| Filed: November 22, 2000 |) | |
| |) | |
| For: A Method for Acquisition, Storage, |) | Confirmation No.: 5398 |
| And Retrieval of Cell Screening |) | |
| Data on a Computer System |) | |

Mail Stop **Patent Ext.**
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. 1.705

Sir:

Applicants respectfully submit the following request for reconsideration of patent term adjustment (PTA) in the above-referenced U.S. Patent Application, under a Notice of Allowance. The fee under 37 C.F.R. § 1.18(e) (\$200) is submitted with this filing and no other fee relating to this matter is believed due. If other fees are associated with the instant request for reconsideration, the Commissioner is authorized to charge the fee(s) to our deposit account 13-2490.

REMARKS & REQUEST

Responsive to the Determination of Patent Term Adjustment posted on the Patent Application Information Retrieval System (PAIR) and provided with the Notice of Allowance, mailed November 17, 2008, and in light of the recent ruling in *Wyeth v. Dudas*, No. 07-1492, slip op. (D.D.C. Sept. 30, 2008) the Patentees submit this Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705. As stated in 37 C.F.R. 1.705(b):

Any request for reconsideration of the patent term adjustment indicated in the notice of allowance, except as provided in paragraph (d) of this section, and any request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) must be by way of an application for patent term adjustment. An application for patent term adjustment under this section must be filed no later than the payment of the issue fee but may not be filed earlier than the date of mailing of the notice of allowance.

While this application has yet to issue as a U.S. Patent, Applicants filed a request for continued examination (RCE) in the application (September 6, 2006), which is effective to cut off any further patent term adjustment that would otherwise accrue under 37 C.F.R. § 1.702(b) [see, 37 C.F.R. § 1.703(b)(1)]. This request is being submitted before payment of the issue fee (due February 17, 2009), and complies with the relevant deadline specified in 37 C.F.R. 1.705. Thus, Applicants contend this request is timely.

The data available on PAIR indicates that the instant application has been granted 1344 days of Patent Term Adjustment. Applicants submit that, due to the recent *Wyeth* decision, the correct Patent Term Adjustment should be 2011 days ($1344 + 667 = 2011$). Applicants, therefore, request that the above-captioned allowed application be granted an additional 667 days of patent term.

Applicants agree with the Patent Office's initial determination, which, for purposes of this request and in keeping with the explanation provided in *Wyeth*, Applicants will refer to as the "A delay." In the "A delay" the Patent Office delayed prosecution by issuing the first communication (Office Action, September 30, 2004) 14 months plus 982 days after the filing of the application (37 CFR 1.703(a)(1)); by issuing a further Office Action (September 2, 2005) 4 months plus 39 days after the filing of a reply (37 CFR 1.703(a)(2)); and by issuing a BPAI decision 629 days after the filing of a

Notice of Appeal (37 CFR 1.703(4)), resulting in a USPTO “A delay” of 1650 total days. In the “A delay” the Patentees delayed prosecution by filing a response to an Office Action 3 months plus 85 days after the mailing of the respective action (Response filed, March 25, 2005)(37 CFR 1.704(b)); by filing a supplemental response 90 days after the filing of the initial response (Response filed, June 23, 2005) (37 CFR 1.704(c)(8)); by filing a response to an Office Action 3 months plus 61 days after the mailing of the respective action (Response filed, February 1, 2006)(37 CFR 1.704(b)); by filing a response to an Office Action 3 months plus 61 days after the mailing of the respective action (Response filed, September 6, 2006)(37 CFR 1.704(b)); and again by filing a Notice of Appeal in response to an Office Action 3 months plus 2 days after the mailing of the respective action (NOA filed, February 15, 2007 (37 CFR 1.704(b)). Therefore the Patentees were responsible for a total of 306 days delay. These delays result in a total “A delay” of 1344 days (1650 – 306 = 1344).

The Patent Office however has **not** included in the Patent Term Adjustment the days related to the “B delay,” which are the days delay resulting from an application pending longer than three years. According to 37 C.F.R. 1.703(b):

The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued...

The instant application was filed on November 22, 2000. As noted above, Applicants filed a request for continued examination (RCE) on September 6, 2006 which is 3 years plus 1019 days after the filing date.

However, the *Wyeth* decision states that “the ‘A period’ and ‘B period’ overlap only if they occur on the same calendar day or days” (*Wyeth*, No. 07-1492, slip op. at 8). There were two overlap periods, in which the “B delay” overlapped calendar days with the “A delay.” In the first overlap the days between November 23, 2003 (the day that is the date that is three years after the date on which the application was filed) and the issuance of the first Office Action on September 30, 2004 is 313 days and has already been included in the “A delay” outlined above. In the second overlap, the days delay between the filing of a reply (March 25, 2005) and the issuance of a further Office Action

(September 2, 2005) is 39 days and has already been included in the “A delay” as outlined above. Thus, the resulting “B delay” is 667 days ($1019 - 313 - 39 = 667$).

Thus, according to the *Wyeth* decision, Patentees are entitled to both the “A delay” of 1650 days and the “B delay” of 1019 days minus any overlap which occurs on the same calendar days (352 days), and minus any Applicant delay (306 days). Thus, the total Patent Term Adjustment due to both the “A” and “B” delays and minus any overlap and Applicant delay is 2011 days ($1650 + 1019 - 306 - 352 = 2011$).

For these reasons, the Patent Term Adjustment for this case should be 2011 days.

In light of the foregoing, the Applicants respectfully request that an additional 667 days of Patent Term Adjustment be added to the patent term for Patent Office delay, resulting in a total Patent Term Adjustment of 2011 days. If a telephone conference would expedite the prosecution of this Request for Reconsideration of Patent Term Adjustment, please contact the undersigned as indicated below.

Required statement under 37 C.F.R. § 1.705(b)(2)(iii) – The above-referenced allowed patent application is not subject to any terminal disclaimer.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff LLP

Date: February 3, 2009

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